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Docket No.: 1317.1031D

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of:

Young-Nam OH

Serial No. 09/556,978

Group Art Unit: 2153

Confirmation No.

Filed: April 24, 2000

Examiner: T. Kupstas

For: HYBRID DISC AND METHOD AND APPARATUS FOR DISCRIMINATING SAME

REPLY BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

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Sir:

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This is in response to the Examiner's Answer mailed February 13, 2003, and having a date for reply of April 13, 2003.

Grouping of Claims

In the Appellant's Brief, the following claims were grouped to stand or fall together: (A) claims (A) 1-3; and (B) 19, 23, and 24. The Examiner's Answer asserts that all of claims 1-3, 19, 23 and 24 should stand or fall together.

Applicant agrees that all of claims 1-3, 19, 23 and 24 should stand or fall together for the purpose of determining patentability over the Admitted Prior Art in view of Tognazzini et al.

The Prior Art of Record:

U. S. Patent 5,959,946 to Tognazzini et al. is listed by the Examiner as the only reference cited by the Examiner in support of the present 35 U.S.C. §103(a) rejection. However, in the Final Office Action, the Examiner's rejection was also based on Admitted Prior Art as disclosed at pages 1 and 2 of the specification.

Rebuttal to Examiner's Response to Argument

The Examiner argues that because Tognazzini et al. stores a serial number on a disc and the disc player stores information correlating the serial number to a type of disc, that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store information on the disc expressing a disc type. The disclosure of Tognazzini et al. at col. 5, lines 60-62, indicates that "whenever a disc is received in the disc drive 200, it is read to determine if the disc is a hybrid disc." However, Tognazzini et al. does not say what is read from the disc to determine that the disc is a hybrid disc. The Admitted Prior Art discloses a problem of reading a disc where it is unknown whether the disc is a hybrid disc. See page 2, lines 21-25 of the specification. Further, the application discloses a solution for the problem. See page 3, lines 3-7, and page 5, lines 9-21.

The disc of Tognazzini et al. is identifiable to a playback system which has initially read the disc, determined that the disc is a hybrid disc and identified the disc as a hybrid disc and stored a serial number of the disc in a memory of the playback system. If the disc should be used in a second system, the second system would not have information stored in a memory that the disc is a hybrid disc based on the serial number of the disc without independently making the same determination as the first system. Applicants claims 1-3, 19, 23 and 24 do not recite the playback apparatus referred to by the Examiner.

The Examiner further states that "[a]lthough the problems sought to be solved by the Applicant may be important, they are not controlling." While not controlling, discovery of the source of a problem is part of the subject matter as a whole to be considered in determining obviousness. In re Pye, 355 F.2d 641, 645, 148 USPQ 426, 429 (CCPA 1966).

Summary

For the reasons set forth above and in the Appeal Brief and the previous Office Action responses filed in this application, it is submitted that the invention as claimed in claims 1-3, 19, 23 and 24 would not have been obvious to a person of ordinary skill in the art in view of the Admitted Prior Art as disclosed in FIG. 1 and at pages 1 and 2 of the specification and FIG. 1 and U.S. 5,959,946 to Tognazzini et al. in view of the Admitted Prior Art et al.

Thus, it is respectfully submitted that the Examiner's final rejection of the claims is without support and, therefore, erroneous. Accordingly, the Board of Patent Appeals and Interferences is respectfully urged to so find and to reverse the Examiner's final rejection.

If any fees are required in connection with the filing of this Reply Brief, please charge same to our Deposit Account No. 19-3935. Respectfully submitted,

Respectfully submitted,

STAAS & HALSEY LLP

Date: 4/3/03

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